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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/775,865      | 02/09/2004  | Thierry Barge        | 4717-13200          | 1501             |

28765 7590 06/03/2005

WINSTON & STRAWN LLP  
1700 K STREET, N.W.  
WASHINGTON, DC 20006

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| EXAMINER |
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ROSE, ROBERT A

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| ART UNIT | PAPER NUMBER |
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3723

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

5/8

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/775,865 | <b>Applicant(s)</b><br>BARGE ET AL. |  |
|                              | <b>Examiner</b><br>Robert Rose       | <b>Art Unit</b><br>3723             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.  
 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28, 42 and 43 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-4, 42 and 43 is/are rejected.  
 7) ☒ Claim(s) 5-28 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Receipt is acknowledged of Applicant's Prior Art Statement, filed February 9, 2004.
2. Applicant's election with traverse of Group I in the reply filed on March 7, 2005 is acknowledged. The traversal is on the ground(s) that the inventions are so closely related as to be best examinable in a single application. This is not found persuasive because as shown in the restriction requirement the inventions were shown to be both independent and distinct. Moreover the inventions would have non-coextensive fields of search, necessitating that a burdensome search be conducted.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 29-41 have been canceled by Applicant.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, and 42-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 4, and 42 the phrase "from out of the cradle support" is not understood. Should this phrase be "out of the cradle support"? In claim 42, lines 8-9 the phrase "once the clamped thereonto..." and "of the jaws caused..." is non-grammatical. In claim 42, lines 12-13 "the projecting element" lacks a proper antecedent basis.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

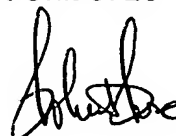
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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinichi(Japan No. 240355). Shinichi discloses an apparatus for splitting apart a substrate comprising two adjoining wafers comprising all of the subject matter set forth in Applicant's claims above. Splitter means(20)(21) comprising moving jaws(24) are applied to opposite sides of the substrate to split the substrate into two wafers. A suction device withdraws one of the two wafers.
7. Claims 5-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 4, and 42-43 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hillberry et al, and Wilkes are cited of interest to show other apparatus for splitting wafers from a substrate utilizing a mechanical wedge shaped member.
10. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (571) 272-4494.

Robert Rose  
Primary Examiner  
Art Unit 3723



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May 25, 2005.